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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,687	03/30/2004	Klaus Pfaffelhuber	MUE-0002-C	8301
23413	7590	05/23/2005		
CANTOR COLBURN, LLP			EXAMINER	
55 GRIFFIN ROAD SOUTH			SAN MARTIN, EDGARDO	
BLOOMFIELD, CT 06002				
			ART UNIT	PAPER NUMBER
			2837	

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/814,687	PFAFFELHUBER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Edgardo San Martin	2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 March 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-35 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. 09/868,680.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/7/04, 6/17/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Specification***

1. The abstract of the disclosure is objected to because:

- The Oath refers to parent case 09/868,680, but the Transmittal Letter refers to the parent application as 09/868,860;
- In page 1 ¶ [002], line 2 should read - -09/868,680- - instead of "09/868,860";
- The Brief Description of Figures 13 and 14 are missing.

Correction is required. See MPEP § 608.01(b).

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims (1 and 35), 2 – 34 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims (1 and 2), 3 – 35, respectively of

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copending Application No. 09/868,680. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

In addition, the recitation in the preamble has been given little patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 5, 9 – 12, 27, 28 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Clarke et al. (EP 0 897 175).

With respect to claims 1, 28 and 35, Clarke et al. teach a sound-shielding element for covering at least one of sound-reflecting or sound-generating structural parts and method of producing it, comprising at least one panel or layer; a plurality of small perforations formed in the at least one panel or layer; wherein an average diameter or width of the perforations ranges between 0.001 and 0.7 mm and a hole/surface ratio ranges between 0.001 and 8% so that the sound waves entering the

perforations initiate physical effects in a gas volume contained in the perforations (Figs. 1 and 2; Col.2, Line 49 – Col.3, Line 21).

With respect to claims 2 – 5, 9 – 12 and 27, the Examiner considers that Clarke et al. teach the limitations described in the claims (Figs. 1 – 3; Col.3, Lines 3 – 38).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 – 8, 13 – 26 and 29 – 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke et al. (EP 0 897 175).

With respect to claims 6 – 8, 29 – 34, Clarke et al. teach the limitations discussed in a previous rejection, but fail to disclose the subject matter described in the mentioned claims.

Nevertheless, the Examiner considers that it would have been an obvious matter of design choice to employ different types of well known manufacturing processes to form the panel because the presence of process limitations, which product does not otherwise patentably distinguish over prior art, cannot impart patentability to the product. *In re Stephens* 145 USPQ 656 (CCPA 1965). Furthermore, the method of

forming the panel is not germane to the issue of patentability of the device itself. Therefore, this limitation has been given little patentable weight.

With respect to claims 13 – 24, Clarke et al. teach the limitations discussed in a previous rejection, but fail to disclose the subject matter described in the mentioned claims.

On the other hand, the Examiner considers that it would have been an obvious matter of design choice to employ the panel in different well known acoustical applications because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

*Ex Parte Masham, 2 USPQ F.2d 1647 (1987).*

With respect to claims 25 and 26, the Examiner takes Official Notice that it is well known in the art of acoustics to employ a perforated panel as a thermal shielding element in certain pertinent applications in order to provide a sound abatement and thermal protection by only one element complying with space or weight constraints. Furthermore, it is also well known in the art of acoustics to employ a perforated panel as a covering layer for a honeycomb panel to create, in combination, resonators that could be tuned to a desired frequency range.

### ***Conclusion***

5. The attached hereto PTO Form 892 lists prior art made of record that the Examiner considered it pertinent to applicant's disclosure.

***Contact Information***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edgardo San Martin whose telephone number is (571) 272-2074. The examiner can normally be reached on 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on (571) 272-2107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Edgardo San Martín  
Primary Examiner  
Art Unit 2837  
Class 181  
May 17, 2005